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09/888,015	06/25/2001	Lionel Breton	016800-450	9059

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EXAMINER

WARE, TODD

ART UNIT	PAPER NUMBER
1615	7

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/888,015	BRETON ET AL.	
Examiner	Art Unit	
Todd D Ware	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 10 January 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 27-41 and 52-65 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 27-41 and 52-65 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

Receipt of request for extension of time (granted), amendment filed 12-31-01 and amendment filed 1-10-02 is acknowledged. Claims 42-51 have been canceled, claims 27-41 have been amended and new claims 52-61 and 62-65 have been added. Claims 27-41 and 52-65 are pending.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-31 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634).

'620, '305, '317, and '634 all disclose hydroxycinnamic acid derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims.

3. Claims 27-31 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Shirota et al (JP 06227959 ; hereafter '959) or Higa (JP 01083009.; hereafter '009) or Ekoshi (JP 63030403; hereafter '403).

'959, '009 or '403 all disclose cinnamic aldehyde derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Governor et al (EP 0 396 422; hereafter '422) in view of Szijjarto nee Auber et al (4,466,961; hereafter '961) or Governor et al (EP 0 396 422; hereafter '422) in view of McAuslan (WO 88/01166; hereafter '166).

'422 teaches cinnamic acid cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of cinnamate in the compositions of '422 is at least that provided in the instant

specification, the amount of cinnamic acid in '422 would be effective as required in the instant claims. Furthermore, it is submitted that it would have been obvious to one skilled in the art at the time of the invention to adjust the amount of cinnamic acid in the compositions to provide a greater or lesser degree of UV protection based upon the motivation of a greater or lesser need/desire for more or less UV protection. '422 does not teach inclusion of at least one other product that stimulates collagen synthesis and/or lipid synthesis.

'961 and '166 each teach inclusion of plant hormones in topical compositions to stimulate endothelialization and angiogenesis.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine '422 with '961 or to combine '422 with '166 and include a plant hormone in the composition of '422 to impart the properties disclosed in '961 and '166 upon the composition of '422 with the motivation of providing nutrients to the skin.

#### ***Response to Arguments***

6. Applicants' arguments filed 1-10-02 have been fully considered but they are not persuasive. Applicants argue that '422 is insufficient to overcome the instant claims since '422 fails to disclose each and every element of the claims since '422 does not recite the process limitations of the claim found in the preamble of the claim. In response, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicants also argue that neither '961 nor '166 do not cure the deficiencies of '422, arguing that neither of these references teach that the addition of these compounds stimulates collagen synthesis and/or lipid synthesis. Again it is noted that these claims are composition claims and the references provide motivation for inclusion of these substances in the cosmetic compositions. In other words, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. Claims 27-31 and 62 are rejected 35 U.S.C. 103(a) as being unpatentable over Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634).

'620, '305, '317, and '634 all teach hydroxycinnamic acid derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims. Furthermore, it is submitted that it would have been obvious to one skilled in the art at the time of the invention to adjust the

amount of hydroxycinnamic acid derivative in the compositions to provide a greater or lesser degree of skin whitening based upon the motivation of a greater or lesser need/desire for more or less skin whitening.

8. Claims 27-31 and 62 are rejected 35 U.S.C. 103(a) as being unpatentable over Shirota et al (JP 06227959 ; hereafter '959) or Higa (JP 01083009 ; hereafter '009) or Ekoshi (JP 63030403; hereafter '403).

'959, '009 or '403 all disclose cinnamic aldehyde derivative cosmetic compositions for lightening skin. No patentable weight is afforded the process limitations and it is submitted that since the amount of hydroxycinnamic acid derivative in the compositions of these references is at least that provided in the instant specification, the amount of hydroxycinnamic acid derivative in these references would be effective as required in the instant claims. Furthermore, it is submitted that it would have been obvious to one skilled in the art at the time of the invention to adjust the amount of cinnamic aldehyde derivative in the compositions to provide a greater or lesser degree of skin whitening based upon the motivation of a greater or lesser need/desire for more or less skin whitening.

9. Claims 32-41 and 63-65 are rejected 35 U.S.C. 103(a) as being unpatentable over any one of Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634) or Shirota et al (JP 06227959 ; hereafter '959) or Higa

(JP 01083009 ; hereafter '009) or Ekoshi (JP 63030403; hereafter '403) in view of Szijjarto nee Auber et al (4,466,961; hereafter '961) or any one of Onuma et al et al (JP 05105620; hereafter '620) or Hotta et al (JP 62036305; hereafter '305) or Naeshiro et al (JP 04009317; hereafter '317) or Onuma et al (JP 05105634; hereafter '634) or Shirota et al (JP 06227959 ; hereafter '959) or Higa (JP 01083009 ; hereafter '009) or Ekoshi (JP 63030403; hereafter '403) in view of McAuslan (WO 88/01166; hereafter '166).

'620, '305, '317, '634, '959, '009 and '403 are relied upon for all that they teach as stated previously. None of these references teaches inclusion of at least one other product that stimulates collagen synthesis and/or lipid synthesis.

'961 and '166 each teach inclusion of plant hormones in topical compositions to stimulate endothelialization and angiogenesis.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine either '620, '305, '317, '634, '959, '009 or '403 with '961 or to combine either '620, '305, '317, '634, '959, '009 or '403 with '166 and include a plant hormone in the composition of these references to impart the properties disclosed in '961 or '166 upon these compositions with the motivation of providing nutrients to the skin.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 27-41 and 62-65 have been considered but are moot in view of the new ground(s) of rejection. However, in the event applicants argue that the instant references fail to disclose each and every element of the claims since they do not recite the process limitations of the claims found

in the preamble of the claims, it is submitted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the event applicants also argue that neither '961 nor '166 cures the deficiencies of the references, arguing that neither of these references teach that the addition of these compounds stimulates collagen synthesis and/or lipid synthesis, it is submitted that these claims are composition claims and the references provide motivation for inclusion of these substances in the cosmetic compositions. In other words, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In the event applicants also argue that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the response of 12-31-01, applicants submitted "absent impermissible hindsight, there is no reason to

rely upon Szijjarto nee Auber et al and McAuslan to modify Governor et al in the manner proposed in the Official Action." As applied to the newly cited references, it is submitted that the motivation is to provide nutrients to the skin and stimulate endothelialization and angiogenesis.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 27-41 and 62-65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-23 of copending Application No. 09/887,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim cinnamic acid compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

tw  
April 7, 2002

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600